

REMARKS/ARGUMENTS

The Advisory Action of February 14, 2006 has been reviewed and the comments therein were carefully considered. Claims 1-23 stand rejected. No new matter has been introduced into the application. As explained in more detail below, Applicant submits that all claims are in condition for allowance and respectfully requests withdrawal of the rejections.

Claim Objection

In the Office Action dated 10/11/2005, Claim 1 was objected to due to the phrase “integrated circuit” failing to recite “card”. The Applicants thank the Examiner for noticing this inadvertent oversight and have amended Claim 1 to recite an “integrated circuit card”. Because the Advisory Action dated February 14, 2006 was silent as to whether the amendment was entered it is being introduced as “Currently Amended” in this Response and Amendment.

Claim Rejections – 35 USC § 112

Claims 1-23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Office Action again asserts the phrase “the content is not provided from the integrated circuit cards” is not disclosed in the specification originally filed on 11/30/2000. The Applicants respectfully traverse the rejection in view of the Remarks below.

The Applicants respectfully traverse the rejection as the Specification, as filed, would have conveyed to one skilled in the art the Applicants had possession of the concept of not using the IC cards as the source of the media. The Office Action, citing M.P.E.P. 2173.05, alleges that the Specification as filed on 11/30/2000 does not explicitly set forth “a definite exclusion of [sic]

IC card as a content provider nor [*sic*] it provides a firm basis for the exclusion if IC card as [*sic*] content provider.” (Office Action dated 10/11/2005; page 4; see also Advisory Action dated 02/14/06; page 2). As explained in section 2173.05, however, the “lack of a literal basis in the specification may not be sufficient to establish a *prima facie* case for lack for descriptive support. (M.P.E.P. 2173.05(i); citing *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993).

As elaborated in *Ex parte Parks*, the test to determine if a negative limitation was adequately disclosed in the Specification is whether the disclosure “convey[s] to one having ordinary skill in the art that the [Applicants] had possession of the concept. (*Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993; emphasis in the original). In finding the claim limitation “in the absence of a catalyst” did not introduce new concepts into the application, the Board focused on 1) the discussion “cry[ed] out” for a catalyst if one were used and no mention was made, and 2) one skilled in the art would recognize that the outcome of the reaction was conducted without a catalyst.

These facts are similar to the present application. First, Figure 1 shows an exemplary electronic content delivery system that shows a host IC card interface (48) receiving a host IC card (62) containing first authorization information and a second IC card interface (50) receiving a user IC card (64) containing second authorization information. Distinctly separated from the host cards is a multimedia database (44) that houses the multimedia files. (*See also*, Specification, page 12, line 9 – page 14, line 5). Like *Ex parte Parks*, the discussion of data flow, more specifically how the IC cards are used, what information the IC cards hold, how the

database is the source of the multimedia content ‘cries out’ for the disclosure that the IC cards are the source of the multimedia content if that were the case – yet no mention is made.

In contrast, the Specification sets forth: “Multimedia database 44 has stored within it a plurality of multimedia files” (Spec., page 12, line 16; see also “When a customer wishes to access a multimedia file from databases 44,...” at page 12, line 20 – 1; emphasis added). Further, the Specification explicitly provides: “[h]ost IC card 62 and User IC card 64 have been encoded therein authorization information which microprocessor compares. The authorization information relates the two cards and identifies files in multimedia database 44 to which the user of IC card 64 is to be permitted access. (Spec., page 13, lines 17 – 21; emphasis added). Not only does the description of the embodiment ‘cry out’ for a disclosure that the IC cards are the source of the multimedia content if that were the case and yet no mention is made, but also one skilled in the art would recognize that the outcome of the process was conducted with the multimedia database, not the IC cards, being the source of the multimedia files.

In fact, the application explicitly states: “Figures 1 and 5 depict systems in which the multimedia files to which access might be obtained are contained within multimedia database 44 within the multimedia terminal 40a or 40b of a kiosk.” (Spec., page 15, lines 2 – 4; emphasis added). Requiring the Applicants to recite each element of the illustrative embodiments that are not the source of the multimedia files would be unduly burdensome and confusing to the reader. The application is replete with examples that demonstrate the Applicants had possession of the concept of not using the IC cards as the source of the media as required by *Ex parte* Parks and M.P.E.P. §2173.05(i). Therefore, the Applicants respectfully traverse the rejection and respectfully request reconsideration and withdrawal of the rejection.

Claim Rejections – 35 USC § 103

Claims 1-23 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ramachandran et al. (U.S. Pat. No. 6,457,640), hereinafter referred to as the ‘640 patent in view of Handelman et al. (U.S. Pat. No. 6,298,441), hereinafter, referred to as the ‘441 patent. The Applicants respectfully traverse the rejection in view of the Remarks below.

The Advisory Action asserts the Applicants’ Response of 01/11/06 merely attacks the references individually. The Applicants respectfully disagree as the Response expressly stated “[n]either the ‘441 patent nor the ‘640 patent suggest a control unit that compares a first authorization information with a second authorization information, that upon being compatible, actuates an output device to provide content of at least one multimedia file selected by the input device.” The Applicants understand that the references cannot be read in isolation, but also what it teaches in combination with the other asserted references (see *In re Merck & Co.*, 231 USPQ 375 (Fed. Cir. 1986)).

The Applicants respectfully submit that the previous Response did not attack the references individually, but rather discussed them in chronological order to demonstrate neither reference taught, disclosed, or otherwise suggested at least one element of the rejected claims. As required by the M.P.E.P., “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (M.P.E.P. §2143; emphasis added). The Office Action dated 10/11/2005 alleged that the ‘640 patent discloses a multimedia delivery system having, *inter alia*, a control unit for actuating said output device to provide the content of a multimedia file. Neither references, however, teach, disclose, or otherwise suggest the control unit as recited in the rejected claims. For example, representative claim 1 of the present application provides:

a control unit, responsive to the host and user integrated circuit cards being received in the first and second integrated circuit card interfaces, which compares the first and second authorization information and when the first and second authorization information is found to be compatible actuates said output device to provide the content of the at least one multimedia file from the content provider selected by said input device under control of the authorization information which authorizes downloading of the at least one authorized multimedia file through the output device

Neither the ‘441 patent nor the ‘640 patent suggest a control unit that compares a first authorization information with a second authorization information, that upon being compatible, actuates an output device to provide content of at least one multimedia file selected by the input device. Indeed, the ATM of the ‘640 patent can at most can be considered to have a first integrated circuit with at most a first authorization information. Along these lines, the invention of the ‘640 patent seems to teach away from the efficiency and user-friendly aspects of the rejected claims. It is directed to increasing the profitability of traditional ATMs by allowing users to browse and potentially download multimedia files in addition to being provided financial services. In contrast, as provided in the originally filed specification of the instant application, “[t]here is no need for browser software in the terminal for downloading purposes. So instead of surfing on the spot, the only active operation the user has to do is to insert a card, or information relating to the card, in the terminal.” (Specification, page 6, lines 11 – 13). The ‘640 patent does not disclose, teach, or otherwise suggest an automatic actuation of the output device to provide at least one multimedia file. This limitation is not taught or otherwise suggested by the ‘441 patent.

While the ‘441 patent may be interpreted as having a first and a second integrated circuit card, there is no actuation of the output device as recited in the rejected claims. Indeed, the first integrated circuit card appears to provide information relating to the service provider whereas the second integrated circuit card relates to parental control over several possible channels that may

Appln. No.: 09/725,713

Response/Amendment dated March 31, 2006

Response to Final Office Action dated October 11, 2005

be viewed upon being manually selected. For example, when the second card is engaged, all the channels that are provided by the service provider are available for viewing, whereas without the card engaged, only a subset, (those approved by the parental controls) are available for viewing. As explicitly provided in the Specification cited by the Office Action, “[i]f the main card is removed from card receptacle 24 none of the transmitted programs [are] decrypted. However, if the parent card is removed from card receptacle 26 only programs which are restricted for viewing under parental control are not decrypted.” (The ‘441 patent; Col. 8, lines 5-9). Merely applying the dual card functionality of the ‘441 patent with the control unit of the ‘640 patent as recited in the rejection does not teach or even suggest the subject matter of the rejected claims.

In view of the foregoing, the Applicants respectfully disagree that the Response of 01/11/06 merely attacked the references individually. Rather, even when considering each reference together, neither teach, disclose, nor even suggest the subject matter of the rejected claims. Therefore, for at least those reasons discussed above and in previous Responses, the Applicants respectfully request reconsideration and withdrawal of the rejection.

Appln. No.: 09/725,713

Response/Amendment dated March 31, 2006

Response to Final Office Action dated October 11, 2005

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: March 31, 2006

By:



Shawn P. Gorman

Reg. No. 56,197

BANNER & WITCOFF, LTD.
10 South Wacker Drive
Suite 3000
Chicago, IL 60606
Tel: (312) 463-5000
Fax: (312) 463-5001